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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,755	03/30/2005	Emmanuel Miette	Q86678	1578
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EXAMINER EPSTEIN, BRIAN M				
ART UNIT 3628		PAPER NUMBER		
NOTIFICATION DATE 12/28/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/529,755

Applicant(s)

MIETTE, EMMANUEL

Examiner

BRIAN EPSTEIN

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 16, 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20050330 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 16, 2009 has been entered.

Status of the Claims

2. Claims 12-16 were previously pending in this application with claims 12, 14, and 16 being subject to a Final Rejection and claims 13 and 15 being withdrawn as being directed to a non-elected invention. Claims 12-16 were canceled and claims 17-20 were newly added in the Request for Continued Examination filed September 16, 2009. Therefore claims 17-20 are currently pending in this application.

Response to Arguments

3. Applicant's arguments filed September 16, 2009 concerning whether new claim 17 is a statutory method have been fully considered but they are not persuasive. Applicant argues, "none of these physical steps are in a claim preamble, each result in statutory subject matter." Examiner notes the test for whether a method is statutory can be found below in the §101 rejection of claims 17-18. Examiner has considered

applicants argument and the limitations of new claims 17 and 18 but respectfully disagrees. Applicant does not appear to argue the steps of claim 17 result in a transformation, and upon review of the claim, examiner notes claim 17 fails the transformation prong of the current test. As to whether the steps of claim 17 are tied to a particular machine, examiner notes the claims certainly fail the tying prong of the current test as well.

None of the method steps of claim 17 require any particular machine whatsoever. At the very best, applicant claims "automatic OCR," which suggests a particular machine is being implemented *but does not require one inherently* (emphasis added). For example, a person certainly can optically recognize destination address information upon forming an image of a current item which includes said destination address information, and then the person can forward the mail piece towards a sorting output. Examiner suggests applicant amend independent claim 17 to specifically recite the particular machine which is performing the claimed method steps.

Claim Objections

4. Claims 19-20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. For example, claim 19 recites, "a postal sorting machine comprising an automatic address resolution system designed to carry out the method of claim 17." It is unclear as to whether claims

19 and 20 are dependent claims or independent claims. Further, examiner notes, if claims 19 and 20 are intended to each be independent claims, it is improper to refer back to other independent claims for limitations, instead, those limitations must be written into claims 19 and 20 themselves since each independent claim must be able to stand on its own.

Claim Rejections - 35 USC § 112 -2nd Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for multiple reasons as indicated below.

Reason 1: Claim 17 recites the steps of "performing automatic OCR recognition," and "forwarding said item towards one of said sorting outputs," (emphasis added). Claim 17 then recites, "and if said destination address information is not recognized unambiguously...perform steps of..."

This claim language makes no logical sense whatsoever. If the method performs automatic OCR recognition of the destination address of an item and then forwards the item towards sorting outputs, as claim 17 clearly requires, the method must have determined the destination address has been read unambiguously in order to forward the item towards the proper sorting output since the "forwarding said item towards one of said sorting outputs is in accordance with the recognized destination address

information." That is, since claim 17 requires forwarding the item toward a sorting output, the issue of whether or not "if said destination address information is not recognized unambiguously..." makes no logical sense. The steps of claim 17 has already decided the destination address is recognized unambiguously in order to forward the item toward the sorting outputs.

Furthermore, it is impossible to perform the method of claim 17. That is, a potential infringer cannot perform OCR of a destination address and then forward said item towards a sorting output (by recognizing the destination address) but then also not recognize the destination address unambiguously, perform the later claimed steps and then forward the item towards a different sorting output.

Reason 2: Claim 17 recites, "and if said destination address information is not recognized unambiguously, said method further comprising..." This language is rejected under §112 since the further limitations/steps of method claim 17, "providing," "detecting," "computing," and; "forwarding," are entirely optional steps, only to occur if said destination address information is not recognized unambiguously (emphasis added). That is, if the destination address is recognized unambiguously, none of the above quoted steps are required by method claim 17. Appropriate correction is required. Examiner reminds applicants that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C.: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.];" and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d

1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.").

Reason 3: Claim 17 then recites, "detecting if said ambiguous possible delivery points are included in a single delivery round...in response to said detection, computing a volume mail data for a delivery range..." Similar to above, the if statement indicates the step of "computing a volume mail data..., and forwarding said current mail item..." are optional, only to occur when the detected ambiguous possible delivery points are, in fact, included in a single delivery round. That is, if the ambiguous possible delivery points *are not* included in a single delivery round, the steps of "computing a volume mail data...and forwarding said current mail item towards a sorting output..." are not required by the language of claim 17.

Examiners Note: For the purposes of the prior art rejections below, examiner interprets claim 17 to include only the "forming an image...", "performing automatic OCR...", and; "forwarding said items...", steps of the method. The steps following "if said destination address information is not recognized..." have not been interpreted by the examiner as being required and thus have not been rejected under §102 or §103 below. Examiner further notes that examiner is available for a phone interview if applicant deems such interview would be advantageous.

7. Claims 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. These claims are omnibus type claims. Claims 19-20 comprise only "an automatic address resolution system." Since applicant is claiming "a postal sorting machine,"

examiner cannot determine what apparatus' said postal sorting machine is required to include. That is, the claimed "automatic address resolution system," is not a functional limitation of the claimed device, it merely appears to be non functional descriptive material describing what the postal sorting machine could potentially do given some unclaimed elements.

8. Claims 18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites "forwarding said current mail item towards a sorting output corresponding to one of said ambiguous possible delivery points if said smallest cumulate extra costs value is less than a second predetermined threshold." Claims 18 and 20 are rejected due to the underlined language. Claims 18 and 20 do not recite "a first predetermined threshold," therefore there cannot be "a second predetermined threshold." Independent claims 17 and 19 do recite "a first determined threshold," however this first determined threshold is related to determined mail volume for a delivery range and has nothing to do with costs.

Examiner suggests applicant amend the thresholds to claim for example "...less than a predetermined *volume threshold*," as per claim 17, and "...less than a predetermined *cost threshold*," as per claim 18.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 17-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of

specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'"

(*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO's "Guidance for Examining Process Claims in view of *In re Bilski*" memorandum dated January 7, 2009,

http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf .

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf> .

Claims 17-18 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claims 17-18 are non-statutory under § 101.

Appropriate correction is required.

11. Claims 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. 35 USC §101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or

composition of matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a postal sorting machine, the body of the claim discusses the specifics of the machine as comprising "an automatic address resolution system," and subsequently the claim then deals with the specifics of a method (from claims 17 and 18) executed by the "automatic address resolution system. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", *Ex parte Lyell* (17 USPQ2d 1548).

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ross et al. (US 2004/0065598).

14. As per **claims 17 and 19**, Ross teaches a method and sorting machine for processing postal items in the sorting machine with sorting outputs, the method and device comprising:

- a. forming an image of a current item including destination address information (Paragraph 0030);
- b. performing automatic OCR recognition of the destination address information from said image (Paragraph 0006; Paragraph 0030), and in cooperation with a reference database (Paragraph 0006), and;
- c. forwarding said item towards one of said sorting outputs in accordance with the recognized destination address information (Paragraph 0007; Paragraph 0030).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al. (US 2004/0065598) as applied to claims 17 and 19 above, and further in view of Welsh (US 7,529,716).

18. As per **claims 18 and 20**, Ross does not explicitly teach, if said ambiguous possible delivery points are not included in a single delivery round defined in said database, computing several cumulated extra cost values associated respectively to said several ambiguous possible delivery points, from predetermined extra costs values representing extra costs of destination error if said current item is delivered either to a wrong delivery office or to a wrong delivery round or to a wrong delivery point, each accumulated extra cost value being an accumulation of said extra cost values which is increased when a detection is made that a delivery office or a delivery round associated with a current ambiguous possible delivery point in said database; identifying a smallest cumulated extra costs value among said computed extra cumulated extra cost values, and; forwarding said current mail item towards a sorting output corresponding to one of said ambiguous possible delivery points if said smallest cumulated extra costs value is less than a second predetermined threshold.

However, Welsh teaches a similar method and apparatus and the method and apparatus of Welsh indeed includes, if said ambiguous possible delivery points are not included in a single delivery round defined in said database, computing several cumulated extra cost values associated respectively to said several ambiguous possible delivery points, from predetermined extra costs values representing extra costs of destination error if said current item is delivered either to a wrong delivery office or to a wrong delivery round or to a wrong delivery point, each accumulated extra cost value being an accumulation of said extra cost values which is increased when a detection is made that a delivery office or a delivery round associated with a current ambiguous

possible delivery point in said database; identifying a smallest cumulated extra costs value among said computed extra cumulated extra cost values, and; forwarding said current mail item towards a sorting output corresponding to one of said ambiguous possible delivery points if said smallest cumulated extra costs value is less than a second predetermined threshold (Column 8, lines 4-55; Column 25, lines 49-53; Column 18, lines 27-60; Column 17, lines 23-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include if said ambiguous possible delivery points are not included in a single delivery round defined in said database, computing several cumulated extra cost values associated respectively to said several ambiguous possible delivery points, from predetermined extra costs values representing extra costs of destination error if said current item is delivered either to a wrong delivery office or to a wrong delivery round or to a wrong delivery point, each accumulated extra cost value being an accumulation of said extra cost values which is increased when a detection is made that a delivery office or a delivery round associated with a current ambiguous possible delivery point in said database; identifying a smallest cumulated extra costs value among said computed extra cumulated extra cost values, and; forwarding said current mail item towards a sorting output corresponding to one of said ambiguous possible delivery points if said smallest cumulated extra costs value is less than a second predetermined threshold, as taught by Welsh in the method and system of Ross, since the claimed invention is merely a combination of old elements, and in the combination each element merely

would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN EPSTEIN whose telephone number is (571)270-5389. The examiner can normally be reached on Monday-Thursday 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. E./
Examiner, Art Unit 3628
December 18, 2009

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628